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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/577,087
Filing Date: April 24, 2006
Appellant(s): PRZEBILLA, HENRIK

Leo J. Jennings
Reg. No 32,902
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 July 2010 appealing from the Office action mailed 19 January 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 8-27 are pending and are currently rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

Art Unit: 3685

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

| | | |
|--------------|------------------|---------|
| 2004/0103312 | Messerges et al. | 05-2004 |
| 2004/0117440 | Singer et al. | 06-2004 |
| 2003/0236978 | Evans et al. | 12-2003 |
| 5,629,980 | Stefik et al. | 05-1997 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

1. This communication is in response to amendments and remarks filed on 30 October 2009.

Claim Status

2. Claims 1-7 have been cancelled. Claims 8-10 have been amended. Claims 11-27 have been added. Claims 8-27 are currently pending and are presented for examination on the merits.

Response to Amendment

3. Claim 8 recites a DRM system and then recites "DRM server device that issues digital rights", "DRM user device that receives the DROs from the DRM server device", a plurality of DRM client devices "...that stores the associated DDOs on the basis of DROs stored in the DRM user device", "that authenticates the DRM client device by the DRM user device". These are all recitations of intended use and do not distinguish the

Art Unit: 3685

claimed invention from the prior art. While functional language may be used in claims it is structure, not function that will distinguish claims from the prior art “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone”, MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Claims 9, 11-14 and 16-19 recite similar recitations which also do not distinguish the claimed invention from the prior art.

4. Claim 15 recites " wherein each DRO represents exactly one permission to use the associated DDO". Claim 20 recites similar language. This is non-functional descriptive material “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability”, *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

5. Claim 10 is directed towards non-statutory subject matter. The claim recites steps of authentication which as claimed "authenticating the DRM user device to a DRM

Art Unit: 3685

server device" and "authenticating a plurality of DRM client devices to said DRM user device" which does not recite a particular machine as performing the authentication; in the broadest reasonable interpretation the authentication would be extra-solution activity. In addition as recited no physical transformation is occurring. A suggested construction would be "authenticating, by a DRM server device, a DRM user device" and "authenticating, by a DRM user device, a plurality of DRM client devices. The claim also recites "determining, with the DRM user device..." which again in the broadest reasonable interpretation could be extra-solution activity. A recommended construction would be "determining, by the DRM user device..." Claim 10 also recites " transferring usage rights from said DRM user device to said DRM client devices..." which again in the broadest reasonable interpretation could be extra solution activity. A recommended construction would be "transferring, by the DRM user device, usage rights to said DRM client devices..."

Response to Arguments

6. Applicant's argument with regard to the 35 U.S.C. § 101 rejection of the claims has been fully considered but is only partly persuasive. As recited claim 10 does not recite a particular machine as performing the method and in the broadest reasonable interpretation could represent extra-solution activity. For the benefit of the Applicant Examiner has provided suggested claim language in the response to Amendment which if incorporated would overcome the rejection.

7. Applicant's argument with regard to the 35 U.S.C. § 112, 2nd paragraph has been fully considered and is not persuasive. In claim 8 for example structure that is recited

Art Unit: 3685

as being part of a particular device is also being recited as manipulated by other devices within the claimed system. As such the scope of the claim cannot be ascertained.

In addition claim 8 recites "a plurality of DRM client devices granted permission by the DRM user device..." and then further recites "a rights interface that requests access to the DROs... after authentication to the DRM user device." The claim is reciting an interaction process between the client device and the user device. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claim 9 recites "a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the associated DDO stored on an authenticated DRM client device". Appellant is describing that the structure only receives the DROs from the server subsequent to an authentication of the DRM user device, which again is a process within a structural claim. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Art Unit: 3685

8. Applicant's argument with regard to the 35 U.S.C. § 102 (e) and 103 (a) rejection of the claims has been fully considered but is moot in view of the new ground(s) of rejection. However Examiner wishes to comment on a remark made by Applicant. Applicant recites that "Messerges warns that security of content in a domain is potentially threatened if users can remotely register devices into a domain over a long distance. Thus, Messerges enforces a "close proximity" requirement that teaches away from the claimed subject matter". A review of Applicant's disclosure regarding the relationship between the user device and the client devices reveals only two types of communication as disclosed. The first as disclosed in paragraph 0058 of the published version of the specification recites a smart card, which is recited in paragraph 0062 "A smart card as a DRM user unit can interact with a terminal or the DRM client unit via a contact or a contactless interface". The second communication is recited in paragraph 0063 recites "The interfacing between the mobile terminal as the DRM user unit and a DRM client unit will preferably be a contactless interface like e.g. ISO 14443 or NFC (near field communication)". These interfaces recite either direct physical contact (disclosed by Messerges with regard to a smart card) or as Messerges discloses "close proximity". Thus Applicant has neither claimed nor recited any structure meeting the requirements of 35 U.S.C. § 112, 1st paragraph that distinguishes the claimed invention in this regard from the disclosure of Messerges. Therefore the "teaches away" argument must be rendered as invalid and without merit.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Art Unit: 3685

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 10 and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Claim 10 recites a method however none of the method steps recite a particular machine as performing the steps; in addition no physical transformation of matter is occurring. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 10 fails prong (1) because the “tie” (e.g. authenticating the DRM user device to the DRM server device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

12. Claims 21-27 are also rejected as being dependent upon claim 10.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 8-9 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

15. Claim 8 recites a system, further recites a DRM client device and then recites that the DRM client device comprises “a first authentication unit that authenticates the DRM client device by the DRM user device”. As such the scope of the claim cannot be ascertained as the claim recites that structure that is part of the DRM client device is being performed by the DRM user device “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...”, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

16. In addition claim 8 recites “a plurality of DRM client devices granted permission by the DRM user device...” and then further recites “a rights interface that requests access to the DROs... after authentication to the DRM user device.” The claim is

Art Unit: 3685

reciting an interaction process between the client device and the user device. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

17. Claim 9 recites “a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the associated DDO stored on an authenticated DRM client device”. Applicant is describing that the structure only receives the DROs from the server subsequent to an authentication of the DRM user device, which again is a process within a structural claim. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112. Therefore, as claim 5 possesses such a deficiency it is rejected for failing to particularly point out and distinctly claim the invention (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

18. Claims 11-15 are also rejected as being dependent upon claim 8.

19. Claims 16-20 are also rejected as being dependent upon claim 9.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3685

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 8-11, 13-16, 18-20 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges (U.S. Patent PG Publication 2004/0103312, hereinafter referred to as Messerges) in view of Singer et al. (U.S. Patent PG Publication 2004/0117440, hereinafter referred to as Singer).

22. As per claim 8

Messerges discloses a DRM server device that issues digital rights objects (DROs) representing permission to use associated digital data objects (DDOs) (0018, 0021, 0025-0026, 0035). The language "that issues..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0021, 0024-0026). The language "that receives..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges does not explicitly disclose a plurality of DRM client devices granted permission by the DRM user device to use a specific DDO. Singer teaches a plurality of DRM client devices granted permission by the DRM user device to use a specific DDO (0030-0031, 0059-0060). The language "that grants..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a data storage unit that stores the associated DDOs on the basis of DROs stored in the DRM user device (0030-0031, 0059-0060). The language "that stores..." is intended use and does not distinguish the claimed invention from the prior art.

Art Unit: 3685

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101). The language "that authenticates..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a rights interface that requests access to the DROs associated with the DDOs stored in said data storage unit after authentication to the DRM user device (0042, 0095, 0101, 0112-0117). The language "that requests..." is intended use and does not distinguish the claimed invention from the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

23. As per claim 9

Messerges discloses a plurality of DRM client devices that store digital data objects (DDOs) (0009, 0018, 0026, 0035). The language "that store..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs (0018, 0021, 0024-0026, 0031, 0035). The language "that issues..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0009, 0018, 0026, 0035). The language "that receives..." is intended use and does not distinguish the claimed invention from the prior art.

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

Messerges does not explicitly disclose that the DRM user device comprises an authentication unit that authenticates the plurality of DRM client devices. Singer teaches that the user unit authenticates the plurality of DRM client devices (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101). The language "that authenticates..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches a DRM user device comprising a rights storage unit that stores DROs received from the DRM server device (0021, 0024-0026, 0030-0032, 0037, 0059, 0114-0115). The language "that stores..." is intended use and does not distinguish the claimed invention from the prior art.

Singer teaches wherein said DROs are accessed by an authenticated DRM client to get permission to use an associated DDO stored on said DRM client device (0113-0117). However this is simply non-functional descriptive material "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP

Art Unit: 3685

2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability”, *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

Singer teaches an interface that receives the DROs from the DRM server device (0021, 0024-0026) and grants usage rights for the associated DDO stored on an authenticated DRM client device (0113-0117). However the recitation “that receives... and grants...” is intended use and does not distinguish the claimed invention from the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

24. As per claim 10

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

Messerges discloses a DRM server device that transfers digital rights objects (DROs) (0018, 0021, 0024-0026, 0031, 0035). However the language “to transfer a requested DRO from said DRM server device to said DRM user device following

Art Unit: 3685

successful authentication” is intended use and does not distinguish the claimed invention from the prior art.

Messerges does not explicitly disclose client devices being authenticated by a user device. Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches the DRM user device determining whether to grant permission to use a specific DDO to different DRM client devices (0077, 0085, 0087, 0113-0117).

Singer teaches when permission is granted, transferring usage rights from said DRM user device to said DRM client devices after successful authentication to permit use of the specific DDO (0077, 0085, 0087, 0113-0117). However the language following the recitation “when permission is granted” is reciting an optional step as if permission is not granted the step will not be performed (MPEP §2106 II C, “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer for the purpose of allowing users to access digital content through various devices in multiple locations while preventing uncontrolled and unauthorized copying and resulting potential problems.

25. As per claim 11

Art Unit: 3685

Singer teaches the user device having authentication capability (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101) and revocation lists (0114-0115).

26. As per claim 13

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

27. As per claims 14 and 24

Messerges discloses a DRM user device that receives the DROs from the DRM server device (0021, 0024-0026) and authentication by the server (0032-0033).

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches an interface that grants access to the DROs associated with the DDOs stored in said data storage unit after authentication to the DRM user device (0042, 0095, 0101, 0112-0117).

28. As per claims 15, 20 and 25

Messerges, while disclosing that rights objects are permissions to use the associated DDO (0021, 0026, 0030, 0035) does not explicitly disclose that each DRO represents exactly one permission to use the associated DDO; however this is non-functional descriptive material and is not entitled to patentable weight.

29. As per claim 16

Singer teaches an authentication unit and the authentication of the DRM client device by the DRM user device (0028, 0036, 0041, 0077-0079, 0083-0084, 0100-0101).

Singer teaches revocation lists (0114-0115).

Art Unit: 3685

30. As per claim 18

Messerges discloses a DRM server device authenticating a DRM user device (0032-0033)

31. As per claims 19 and 26

Singer teaches a limited number of supported clients (0205).

32. Claims 12, 17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges in view of Singer and in further view of Evans et al. (U.S. Patent PG Publication 2003/0236978, hereinafter referred to as Evans).

33. As per claim 12

Neither Messerges nor Singer explicitly disclose updating a revocation list remotely. Evans teaches remote updating of a revocation list (0059, 0066, 0089, 0144, 0149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

34. As per claim 17

Neither Messerges nor Singer explicitly disclose updating a revocation list remotely. Evans teaches remote updating of a revocation list (0059, 0066, 0089, 0144, 0149).

Art Unit: 3685

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

35. As per claim 21

Neither Messerges nor Singer disclose storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client. Evans teaches storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client device (0059, 0066, 089, 0144, 0149).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the secure media path method of Evans for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

36. As per claim 22

Evans teaches using the DRM server device to update the revocation list stored in the DRM user device (0059, 0066, 089, 0144, 0149).

Art Unit: 3685

37. As per claim 23

Evans does not explicitly teach performing mutual authentication of the DRM server device and the DRM user device; however as Evans teaches distributed authentication at various levels of the chain with authenticators (Abstract, 0010, 0024, 0090) a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Evans would be the installation of authenticators at both the DRM server device and the DRM user device to authenticate each other for the purpose of providing architectures infrastructure where layers are required to be trusted, thereby allowing untrusted applications to play protected content without knowledge of it being protected.

38. **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges in view of Singer and in further view of Stefik et al. (U.S. Patent 5,629,980, hereinafter referred to as Stefik).**

39. As per claim 27

Neither Messerges nor Singer teach that a DRO can be transferable. Stefik teaches transferable DROs (Abstract, Figure 15, 35:1-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain-based digital rights management system of Messerges with the media network environment of Singer further with the system for controlling the distribution of digital works of Stefik for the purpose of allowing the owner of a digital work to attach usage rights to the work.

(10) Response to Argument

Appellant's argument with regard to the 35 U.S.C. § 101 rejection of claims 10 and 21-27 has been fully considered but is not persuasive. Claim 10 recites "A digital rights management (DRM) method performed in a DRM system, said DRM system comprising a plurality of DRM client devices that store digital data objects (DDOs), a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs, and a DRM user device that interacts with said DRM client devices and said DRM server device, said method comprising the steps of:

authenticating the DRM user device to the DRM server device to transfer a requested DRO from said DRM server device to said DRM user device after successful authentication;

authenticating a plurality of DRM client devices to said DRM user device;

determining, with the DRM user device, whether to grant permission to use a specific DDO to different DRM client devices; and

when permission is granted transferring usage rights from said DRM user device to said DRM client after successful authentication to permit use of the specific DDO".

In the first step of authenticating the DRM user device to the DRM server no particular machine has been recited as performing the authentication step. The DRM user device is simply the object of the authentication and the DRM server device would presumably receive the authentication information regarding the DRM user device. Therefore nothing within the claim recites the machine performing the step. The language "to transfer a requested DRO from said server device to said DRM user

Art Unit: 3685

device after successful authentication” is only a suggested step that may be performed after authentication; however this recitation does not mandate that any particular device perform the suggested transfer and in any event it cannot be given weight as it is not part of the claimed method. Therefore this limitation contains no recitation regarding a particular machine as conceivably any device recited within the preamble could perform this function. The disclosure in Figure 1 and paragraphs 0046-0047 recite that the DRM server unit 1 comprises an authentication unit 11 and the DRM user unit 2 comprises an authentication unit 21 however as neither paragraph provides an explicit recitation of the authentication process and paragraphs 0011-0012, 0048 and 0051-0052 only recite vague recitations regarding a unit authenticating "itself to..." it is unclear if authentication of a particular device can be performed at an individual device or if the authentication requires the participation of two devices. Therefore as a particular device has not been recited within the claim as performing the authentication step and the disclosure is broad enough to encompass the authentication being performed by either a single device or multiple devices the recited limitation cannot be viewed as either reciting a particular machine or involving a physical transformation of underlying subject matter.

The second step authenticating a plurality of DRM client devices to said DRM user device suffers from the same problem regarding authentication that is suffered by the first authentication step. No particular machine is recited as performing the authentication, the step only recites the object of the authentication and no physical transformation of underlying subject matter is taking place. The disclosure in paragraph 0051 regarding the authentication of DRM client devices and a DRM user device is at

Art Unit: 3685

least broad enough in scope to convey to one of ordinary skill in the art that authentication would in fact require both devices to participate in the authentication "...a challenge-response handshake" and therefore no particular device is tied to the second step of authentication. Again as no particular device has been recited within the claim as performing the authentication step and the disclosure is broad enough to encompass the authentication being performed by either a single device or multiple devices the recited limitation cannot be viewed as either reciting a particular machine or involving a physical transformation of underlying subject matter.

The third step "determining, with the DRM user device, whether to grant permission to use a specific DDO to different DRM client devices" is the only step that would appear to actually recite a device involved in the execution of a step. However the disclosure in paragraph 0033 recites that "The limited number of supported DRM clients can, for instance, be determined by the DRM server prior to issuing the DRO to the DRM user unit. In this way the DRM system is flexible to support different operation schemes as defined by the issuer of the digital rights objects". This appears to be the only recitation in the disclosure that actually involves the determination as to whether a DRM client device is to be granted permission to use a specific DDO. In this paragraph the DRM server is disclosed as performing the act of determination and at least suggests that the DRM user device is only acting as a transfer conduit for the determination performed by the DRM server device. As such the word "with" as used in the limitation "determining, with the DRM user device" cannot be viewed as a positive recitation of the DRM user device actually performing the determination when viewed in

Art Unit: 3685

the broadest reasonable interpretation in light of the specification as the disclosure from paragraph 0033 would lead one of ordinary skill in the art to infer that the majority if not the entirety of the determination is being performed by the DRM server and the role of the DRM user device appears to be only that of mere insignificant extra-solution activity. For this reason this step cannot be viewed as tying the claim to a particular machine or providing a recitation regarding a physical transformation involving underlying subject matter and may constitute nothing more than mere insignificant extra-solution activity.

The fourth recitation “when permission is granted, transferring usage rights from said DRM user device to said DRM client devices after successful authentication” also does not recite a particular machine performing the method step nor does it recite a physical transformation involving underlying subject matter. While the DRM server is not recited within this limitation it is noted that in the disclosure in paragraph 0046 it is stated that “A DRM server unit 1: this server manages and controls the transfer of digital rights objects into the user domain”. As there is no specific recitation of a particular machine performing the step of transferring it is clear that the limitation when read in the broadest reasonable interpretation in light of the specification can be viewed as being performed by the DRM server, the DRM user device or a combination of both. For this reason this step cannot be viewed as tying the claim to a particular machine or providing a recitation regarding a physical transformation involving underlying subject matter and may constitute nothing more than mere insignificant extra-solution activity.

Claim 21 recites “storing a revocation list of DRM client units in the DRM server device, wherein a second authentication unit in the DRM server device, wherein a

Art Unit: 3685

second authentication unit in the DRM user device checks the revocation list during authentication of each DRM client device". The disclosure in paragraph 0046 only recites in the passive "...a revocation list stored in a revocation list storage 12 to check the integrity of the receiver of the receiver of DROs" without reciting the device performing the storing. The recitation of paragraph 0050 "After the transactions between the DRM server unit 1 and the DRM user unit 2..." does not provide an explicit recitation regarding the transactions and leaves open the possibility that the DRM user unit may be operating upon the revocation list of the DRM server unit. Therefore as the claim does not recite a particular machine performing the step of storing and no physical transformation is occurring on underlying subject matter this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 22 recites "...using the DRM server device to update the revocation list stored in the DRM user device". This is not a positive recitation of either device performing updating, and the word "using" could be viewed as a mere insignificant data gathering step as the disclosure is somewhat vague per paragraphs 0049-0050 as to the updating mechanism taking place. Paragraph 0047 recites regarding the authentication unit 21 and revocation list storage 22 "Both elements are provided and maintained by the operator of the DRM server unit 1" however it is not clear whether this is referring to the actual revocation list or simply the storage unit containing the revocation list. Therefore when viewing the claim in the broadest reasonable interpretation in light of the disclosure the claim does not recite a particular machine performing the step of updating and no physical transformation is occurring on

Art Unit: 3685

underlying subject matter; therefore this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 23 recites "...performing mutual authentication of the DRM server device and the DRM user device". While the objects of the "mutual authentication" are recited, the claim does not specifically tie the act to any particular machine and could be performed by one of the two recited machines or both. Therefore when viewing the claim in the broadest reasonable interpretation in light of the disclosure the claim does not recite a particular machine regarding the act of "performing" and no physical transformation is occurring on underlying subject matter; therefore this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 24 recites "receiving the DROs from the DRM server device with an authenticated DRM user device; and granting usage rights for the associated DDO stored on an authenticated DRM client device". The step of "receiving" does not recite the particular machine performing the step; moreover it appears to be a simple data gathering step. The step "granting usage rights..." would appear to be similar to the step of "determining" in claim 10 where the disclosure in paragraph 0033 recites that "The limited number of supported DRM clients can, for instance, be determined by the DRM server prior to issuing the DRO to the DRM user unit. In this way the DRM system is flexible to support different operation schemes as defined by the issuer of the digital rights objects". The claim recites no particular machine as performing the "granting"; moreover given the recitation from paragraph 0033 the disclosure can be viewed as broad enough to encompass either the server or the user device performing this step or

Art Unit: 3685

both. Therefore when viewing the claim in the broadest reasonable interpretation in light of the disclosure the claim does not recite a particular machine regarding the act of "granting" and no physical transformation is occurring on underlying subject matter; therefore this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 25 recites "wherein each DRO represents exactly one permission to use the associated DDO" and is not reciting a method step; therefore this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 26 recites "determining, with the DRM server device, a limited number of supported DRM clients that can access the DDOs". This recitation appears to be similar to the recitation of claim 10 "determining, with the DRM user device, whether to grant permission to use a specific DDO to different DRM client devices" and in fact underscores Examiner's point that the broadest reasonable interpretation in light of both the claims and the disclosure points to no particular machine performing either step and that the disclosure is broad enough to be viewed as disclosing that either or both the server device or the user device or both are involved in the determination as the disclosure is rather vague on this point. Therefore this recitation does not positively bring the claim within the realm of patent eligible subject matter.

Claim 27 recites "...defining each DRO as either transferable or non-transferable". The claim is broad enough to not involve any machine as "defining" could simply be performed in the mind of a user or the content owner.

Therefore when viewing claims 10 and 21-27 as a whole, given that there is no particular machine recited within any of the claims, no physical transformation is occurring on underlying subject matter, the recitations involving a machine are either not directed towards a particular machine or only involve mere insignificant extra-solution activity, a finding is made that the claims as a whole are directed to ineligible subject matter under 35 U.S.C. § 101.

Appellant's argument with regard to the 35 U.S.C. § 112, 2nd paragraph rejection of claims 8, 9 and 16-20 has been fully considered but is not persuasive. Appellant points to MPEP § 2173.06, however Examiner would point to the same section of the MPEP regarding two approaches to claim examination when a claim is indefinite which states that "The first approach is recommended from an examination standpoint because it avoids piecemeal examination in the event that the examiner's 35 U.S.C. 112, second paragraph rejection is not affirmed, and may give applicant a better appreciation for relevant prior art if the claims are redrafted to avoid the 35 U.S.C. 112, second paragraph rejection". Thus the Examiner is following the approach to examination recommended by the MPEP.

Appellant's argument with regard to the portion of the Final Office Action in the Response to Amendment where Examiner indicated that portions of claim 8 were directed towards intended use have been fully considered but are not persuasive. Appellant has cited a portion of MPEP § 2173.05(g) regarding functional language. However the same section of the MPEP recites "Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph, is a different issue from whether the

Art Unit: 3685

limitation is properly supported under 35 U.S.C. 112, first paragraph, or is distinguished over the prior art". *Swinehart* is directed towards whether functional language renders a claim indefinite under 35 U.S.C. 112, second paragraph. In the Response to Amendment, Examiner simply indicated that as claim 8 is directed towards an apparatus the functional language recited in the claim does not comprise or impose a structural limitation on the recited system, a system being defined as a device or collection of devices, and therefore would not distinguish the recited system from the prior art. Examiner made no indication in the Response to the Amendment that the cited language was being held as indefinite but rather pointed out the corresponding section regarding functional language in an apparatus claim i.e. MPEP § 2114; therefore Examiner does not see that this is germane to the 35 U.S.C. § 112, 2nd paragraph rejection of claims 8, 9 and 16-20.

Appellant's final argument with regard to the 35 U.S.C. § 112, 2nd paragraph of claims 8 and 9 has been fully considered but is not persuasive. Claim 8 recites "a plurality of DRM client devices granted permission by the DRM user device..." and then further recites "a rights interface that requests access to the DROs... after authentication to the DRM user device." It is the Examiner's view that the claim is reciting an interaction process between the client device and the user device. The claim recites authenticating the DRM client device by the first authentication unit and then recites requesting access to the DROs associated with the DDOs stored in said data storage unit after authentication to the DRM user device. In Examiner's view this represents more than the recitation of functional language in an apparatus claim, but is indicating a

Art Unit: 3685

sequence of steps that is to be followed in using the apparatus. Claim 9 is similar in that it recites “a second interface that receives the DROs from the DRM server device after the DRM user device is authenticated and grants usage rights for the associated DDO stored on an authenticated DRM client device”, which is again a process being followed of authenticating, receiving and granting. Again in Examiner’s view this represents more than the recitation of functional language in an apparatus claim, but is indicating a sequence of steps that is to be followed in using the apparatus.

Examiner also notes that another 35 U.S.C. § 112, 2nd paragraph rejection of claim 8 was presented in the Final Office Action “Claim 8 recites a system, further recites a DRM client device and then recites that the DRM client device comprises “a first authentication unit that authenticates the DRM client device by the DRM user device”. As such the scope of the claim cannot be ascertained as the claim recites that structure that is part of the DRM client device is being performed by the DRM user device “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...”, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)”. Examiner does not see any particular argument by Appellant on this rejection; however Examiner notes that the recited “authentication unit” in the client device is unclear not only for the cited reason but also because of the fact that while the disclosure explicitly shows authentication units in the DRM server device and the DRM user device (see Figure 1) no such explicit showing is made regarding an authentication unit being within the client devices but only vague recitations within paragraph 0012 “the DRM client preferably has to

Art Unit: 3685

successfully authenticate itself to the DRM unit” and paragraphs 0016, 0022, 0027, 0029, 0044, 0048, 0051-0053 and 0070 and originally presented claim 8 which do not actually make an explicit recitation of an authentication unit being in the client but only describe the function of authentication. As such it is not clear exactly what is being referenced by the “authentication unit” of amended claim 8 that is being claimed as being present within the DRM client device and the language of the claim is not clear with regard to the function that being recited as part of this DRM client device “first authentication unit” as it appears that the structure within the client device is reciting that the function is being performed by the user device and is therefore unclear. As some form of authenticating was associated with the client device Examiner did not deem a new matter rejection to be appropriate; however as neither the structure or the function could be ascertained Examiner maintains that this recitation regarding the authentication unit must at least be held as indefinite.

Appellant’s argument with regard to the 35 U.S.C. § 103 (a) rejection of claims 8-11, 13-16, 18-20 and 24-26 has been fully considered but is not persuasive. Examiner would first point out that while Examiner pointed out instances in the rejection of language which are merely directed towards intended use and non-functional descriptive material that are within the claims that Examiner supplied prior art rejections with each claim with the explicit exception of claims 15, 20 and 25; therefore Examiner views the argument as not being germane to claims 8-11, 13-14, 16, 18-19, 24 and 26. With regard to claims 15 and 20 the nature of the DRO “represents exactly one permission to use the associated DDO” does not impose a structural limitation on the

Art Unit: 3685

claims and simply represents stored data which in this case is non-functional descriptive material and does not distinguish the apparatus of claims 8 and 9. Similarly claim 25 does not recite a method step and the nature of the DRO does not have a manipulative effect on the recited method and again does not represent anything other than non-functional descriptive material which does not distinguish the claimed invention from the prior art. Therefore the recitations were appropriately indicated by the Examiner as not being entitled to patentable weight and as such do not distinguish the claimed invention from the cited art. As such Appellant's citations with regard to MPEP § 2143.03 and MPEP § 2111 are not germane for the reasons cited above.

Appellant's further argument with regard to the 35 U.S.C. § 103 (a) rejection over Messerges in view of Singer of claims 8-11, 13-16, 18-20 and 24-26 has been fully considered but is not persuasive. Appellant cites MPEP § 2111.02 and *In re Otto* regarding the preamble however presents no argument as to how the preambles of the claims limit the claims. With regard to claim 8 the preamble merely recites "A digital rights management (DRM) system comprising:" and in claim 9 the preamble merely recites "A digital rights management system comprising:"; however in both claims the body of the claims recites the structure and therefore Examiner does not see why Appellant would allege that these preambles place meaningful limits on the either claims 8 or 9. The preamble of claim 10 recites "A digital rights management (DRM) method performed in a DRM system, said DRM system comprising a plurality of DRM client devices that store digital data objects (DDOs), a DRM server device that issues digital rights objects (DROs) representing permission to use associated DDOs, and a DRM

Art Unit: 3685

user device that interacts with said DRM client devices and said DRM server device, said method comprising the steps of:". Examiner does not see any language within the preamble of claim 10 that either does not duplicate the actual method steps or would not be required as part of the method steps. For example the "DRM server device that issues digital rights objects (DROs) would seem to be a requirement of the suggested action "to transfer a requested DRO from said DRM server device". Appellant did not present any argument that pointed to a specific instance where the preamble of claims 8-10 placed any meaningful limitation on the scope of those claims but merely made a conclusory statement without any factual basis behind the statement. The remainder of the claims placed in this argument i.e. 11, 13-16, 18-20 and 24-26 only recite typical preambles found in dependent claims that link those claims with independent claims 8-10. As such Examiner views the rejections of claims 8-11, 13-16, 18-20 and 24-26 as appropriate.

Appellant's argument with respect to the 35 U.S.C. § 103 (a) rejection over Messerges in view of Singer and in further view of Evans of claims 12 and 17 has been fully considered but is not persuasive. Evans teaches in paragraph 0144 that "revocation lists can be transmitted over the various components, e.g. a server can send the revocation list to the client who can then send the list down the processing chain to the remote device". The claim is directed towards the DRM server device and recites that it further comprises "a second revocation list storage unit that updates the revocation list stored in the first revocation list storage unit in the DRM user device". The Examiner deems these two recitations to be synonymous. Appellant has not

Art Unit: 3685

provided any explanation as to why the revocation list of Evans that is recited as being sent by the server device is different than that of the claimed invention and paragraph 0089 recites that the list is sourced by "a secure server" which would be deemed by those skilled in the art as indicative that the revocation list is stored in the secure server; therefore Examiner deems that the Evans reference teaches every element of claim 12 and similarly claim 17.

Appellant's argument with respect to the 35 U.S.C. § 103 (a) rejection over Messerges in view of Singer and in further view of Evans of claim 23 has been fully considered but is not persuasive. Upon further review of the Evans reference it is noted that in figure 6 a content source is shown in the upper half of the figure and a remote device is shown in the lower half of the figure. Paragraph 0049 teaches that a content source is both a server and a component (see also the remote device in paragraph 0136). Paragraph 0058-0059 teach that a local device may also provide content. Paragraph 0102 teaches that a component "can also have the ability to add restrictions to the license as a first pass in the authentication" and that "This can allow components (e.g. decoders) to require other components to be interrogated for compatibility". Paragraph 0109 teaches that "An authenticator verifies components and establishes encrypted channels to other authenticators". In the embodiment shown in Figure 6 and taught in paragraphs 0134-0139, both the top half and the bottom half of the figure contain authenticators and each half would view the other half as a component. Paragraph 0136, for example further recites that "...one or more authenticators such as primary authenticator 618 and secondary authenticator 620, can reside on one side of a

Art Unit: 3685

network connection such as on a host". Paragraph 0138 teaches that "...there is a logical connection between the authenticators on both sides of the network (e.g. authenticators 620 and 622). This logical connection is authenticated and encrypted for all of the reasons set forth above". Finally paragraph 0139 teaches "Once the various components on each side of the network have been authenticated, the protected content can be provided to remote device 624 for rendering". Thus in Examiner's view the recitation of paragraph 0139 is disclosing "mutual authentication" as recited within claim 23 as the authenticators in the server and the remote device are authenticating and verifying each other.

Appellant's argument with regard to the 35 U.S.C. § 103 (a) rejection over Messerges in view of Singer and in further view of Stefik of claim 27 has been fully considered but is not persuasive. Appellant states in argument that "Appellant submits that the claim language is related defining (sic) the state of a DRO". However the word "state" does not appear within the language of the claim. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., state) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However as the Stefik reference recites transferable DROs (Abstract, Figure 15, 35:1-29) that in particular element 1505 of Figure 15 and the associated disclosure of column 19, line 58 through column 20, line 4 disclose the grammar element that includes the restriction regarding whether or not the

Art Unit: 3685

DRO is either transferable or non-transferable and certainly meets the claim of "defining each DRO as either transferable or non-transferable" and would also meet the Appellant's unclaimed recitation regarding the "state" of the DRO.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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